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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/695,479  | 10/28/2003  | Danilo Mascolo       | 856063.754          | 5220             |
| 38106   | 7590        | 12/07/2004           | EXAMINER            |                  |
| SEED INTELLECTUAL PROPERTY LAW GROUP PLLC<br>701 FIFTH AVENUE, SUITE 6300<br>SEATTLE, WA 98104-7092 |             |                      | NHU, DAVID          |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2818                |                  |

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/695,479             | MASCOLO ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | David Nhu              | 2818                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTIONS*****Election/Restrictions***

1. Applicant's election of Group I (Claims 1-17) is acknowledged. Claims 1-17 are remained for examination. Accordingly, claims 18-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claims Objection***

2. **Claim 1**, "the nanoclusters" should be --the metallic passivated nanoclusters-- because it lacks a clear antecedent basis.

**Claim 3**, "synthesizing metallic nanoclusters" should be -- synthesizing metallic passivated nanoclusters-- ; and "the nanoclusters" should be --the metallic passivated nanoclusters--

**Claim 4**, "the metal" should be --the active metal—

"the thiol-passivated nanoparticles" lack a clear antecedent basis.

**Claims 11, 12**, "the nanoparticles" should be –the conductive nanoparticles –

**Claim 14**, "the nanoparticles" should be –the metal nanoparticles--

**Claim 13**, "the thiol-passivated nanoparticles" lack a clear antecedent basis.

**Claim 16**, "the electric field" should be –the non-homogenous electric field–

"the nanoclusters" should be –the metallic passivated nanoclusters--

"the nanocontact as a target" lack a clear antecedent basis.

**Conclusion**

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Clauss'887, Winningham'463, Jacobson'083 are cited as of interest.
4. A shortened statutory period for response to this action is set to expire 3 (three) months

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and 0 (zero) day from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see 710.02 (b)).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Nhu, (571)272-1792. The examiner can normally be reached on Monday-Friday from 7:30 AM to 5:00 PM. The examiner's supervisor, David Nelms can be reached on (571)272-1787.

*The fax phone number for the organization where this application or proceeding is assigned is (571)273-1792.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956*

David Nhu





December 1, 2004